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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,145	03/02/2004	Mitzi R. Hail	08324.0005-00000	3036

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EXAMINER	
LE, LINH GIANG	

ART UNIT	PAPER NUMBER
3686	

MAIL DATE	DELIVERY MODE
10/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/790,145	HAIL ET AL.	
	Examiner	Art Unit	
	MICHELLE LE	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to Amendment and Remarks filed 02 July 2008. Claims 1, 7, 8, 12, 16, 21, 24-27, 29-31, 33, 34, and 36 are amended and claims 1-36 remain pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 7 and 26 are rejected under 35 USC 101 for failing to qualify as a patent eligible process under 35 USC 101. In order to qualify as a patent eligible process under 35 USC 101, the process must be tied to another statutory class (such as a particular apparatus) or transform underlying subject matter to a different state or thing. Claims 1, 7 and 26 are directed towards a method for processing insurance claims. However the claims are not tied to any particular apparatus for which to process the insurance claims thus recites purely mental steps. The method further does not identify any material that is being changed to a different state. Therefore, claims 1, 7 and 26 are not directed toward a patent eligible process under 35 USC 101. Claims 2-

5, 8-11, and 27-29 incorporate the deficiencies from the independent claims from which they depend upon.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kucera (4,773,009) in view of Rojewski (7,343,308) for substantially the same reasons as stated in the 4/3/08 Office Action:

6. As per claim 1, Kucera and Rojewski collectively teach a method for processing insurance claims comprising:

analyzing text (Kucera; (Col. 3, line 65 to Col. 4, line 15);

assigning a score to each of the data elements (Kucera; Col. 9, line 43 to Col. 10, line 8);

Kucera does not expressly teach the text is associated with an insurance claim to extract data elements related to the insurance claim's subrogation potential and determining if the insurance claim has subrogation potential based on the scores assigned to each of the data elements. However this is well known in the art as

evidenced by Rojewski. In particular, Rojewski teaches a system and method to automatically score a claim and determine the likelihood of subrogation potential (Rojewski; Col. 2, lines 33-50). Thus the idea of scoring an insurance claim to determine subrogation potential was old and well known in the art. Since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

7. Kucera does not expressly teach storing the extracted data elements in data tables corresponding to the insurance claim. However, this is well known in the art as evidenced by Rojewski. In particular, Rojewski teaches claim files stored in the data warehouse (Rojewski; Col. 3, lines 3-20). Since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

8. As per claim 3, Kucera teaches wherein the analyzing further comprises:
separating the text into words (Kucera; Col. 9, line 43 to Col. 10, line 8);
collecting the words into groups (Kucera; Col. 9, line 43 to Col. 10, line 8);and
parsing the groups into the data elements (Kucera; Col. 9, line 43 to Col. 10, line 8).

9. As per claim 4, Kucera teaches wherein the groups are non-sentence groupings (Kucera; Col. 9, line 43 to Col. 10, line 8).

10. As per claim 5, Kucera teaches wherein the non-sentence groupings are compared to a dictionary before being entered into the data table (Kucera; Col. 4, lines 1-15).

11. As per claim 6, Kucera teaches wherein the groups are sentences (Kucera; Col. 4, lines 48-56).

12. Claims 7-11, 12-15, 16-20, 21-23, 24-29, 30-32, 33-26 repeat substantially the same limitations as claims 1-6 and are taught by Kucera and Rojewski collectively. The reasons for rejection are incorporated herein.

Response to Arguments

13. Applicant's arguments filed 7/2/08 have been fully considered but they are not persuasive.

14. Applicant argues that Kucera in view of Rojewski does not teach the newly added limitations of: developing a subrogation potential score for each of the data elements

wherein the developing further comprises: calculating the subrogation potential score using a set of rules created from existing historical claim data, *or* assigning the subrogation potential score using the set of rules. Examiner disagrees. Rojewski teaches valuing a subrogation opportunity by reviewing criteria such as accident description, loss state, responsible party etc...(Rojewski, Col. 2, lines 33-50). Examiner submits this reads upon assigning a subrogation potential score using a set of rules. Further Rojewski teaches factor values are derived from an assessment of similar historical claims recoveries (Rojewski; Col. 2, lines 60-65) which reads upon calculating a subrogation potential score using a set of rules created from exiting historical claim data.

15. Applicant further argues there is no motivation to combine the applied references. Examiner disagrees. As discussed in the *KSR International Co. v. Teleflex Inc. et al.*, 127 S.Ct 1727 (2007), "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ('[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with

some rational underpinning to support the legal conclusion of obviousness'). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ" (emphasis added). In this case, it would have been obvious to add the teachings of Rojewski to calculate subrogation potential with Kucera with the motivation of identifying subrogation potential and subrogation file valuing (Rojewski; Col. 1, lines 13-16). Furthermore the subrogation scoring of Rojewski in combination with Kucera would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results of the combination were predictable.

16. Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Examiner believes the combined teachings of Kucera and Rojewski teach Applicant's claimed limitations.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELLE LE whose telephone number is (571) 272-8207. The examiner can normally be reached on 8 AM - 5PM, M-F.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/M. L./
Examiner, Art Unit 3626
9/30/08

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3626